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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/665,754

09/19/2003

James J. Pagliuca

1291.1139101

8425

28075 7590 04/15/2008  
CROMPTON, SEAGER & TUFTE, LLC  
1221 NICOLLET AVENUE  
SUITE 800  
MINNEAPOLIS, MN 55403-2420

EXAMINER

NGUYEN, VI X

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

04/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/665,754	<b>Applicant(s)</b> PAGLIUCA ET AL.	
	<b>Examiner</b> Victor X. Nguyen	<b>Art Unit</b> 3734	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/30/2008</u>   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. The request filed on 1/30/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/665,754 is acceptable and a RCE has been established. An action on the RCE follows.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,3-5,7,9-12,14,16-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Nwawka. (6,036,638).

Nwawka discloses in figures. 1 and 4, a surgical tool assembly including: an expandable tubular structure 103 has an inner surface defining a path through the tubular structure for receiving surgical instruments, where a surgical tool structured 20 is able to expand the tubular structure, where the tool includes a first leg at 30, a second leg at 40. Regarding the intended use” said first and second ends *being moveable away from each other to apply a radially outwardly directed force to the inner surface of the tubular structure* and cause expansion of the tubular structure *to increase a cross-sectional area of the path along a portion of the path”* The statement of intended use and other functional statements have been carefully considered but are deemed not to impose any structure limitations on the

claims distinguishable over Nwawka reference which is capable of being used as claimed if one desires to do so. Furthermore, the actuator 90 at best seen in fig. 1 definitely is able to move axially which moves the first and the second legs away from each other .

As to claim 3, Nwawka discloses a first 38 and second handles (from segment 44 to segment 90), where the handles move toward each other to move the first and second legs away from each other (fig.1).

As to claims 5 and 7, Nwawka disclose a member or a depth limiter (occurs from segment 58 to segment 60) which is able for limiting the depth as the surgical tool extends into the passage in the tubular structure or is able to limit the distance of the legs move away from each other.

As to claim 9, it noted that fig. 1 of Nwawka clearly defined the tool including the first and second handles *being movable toward each other to pivot said first and second legs relative to each other and move said first and second ends away from each other* (a functional limitation): Thus , a reference needs not show the structure of the recitation in order to meet the claim language but rather the reference needs only be capable of being used with such structure. Accordingly, the reference is considered to read on the claimed limitation of the claimed noted.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 6,8,13,15 and 19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Nwawka (6,036,638) in view of Gerrone (5,312,351). Nwawka discloses the invention substantially as claimed. Nwawka is silent regarding a depth limiter includes a plurality of positions along the surgical tool.

Gerrone discloses such a depth limiter includes a plurality of positions along the surgical tool (see fig. 7d).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nwawka by making the device has a depth limiter includes a plurality of positions along the surgical tool as taught by Gerrone to allow prediction result of adding an additional safety and control to the instrument. As to claims 13 and 19, Gerrone teaches a spring 16 disposed around the actuator.

#### ***Response to Arguments***

4. Applicant's arguments filed 1/30/2008 have been fully considered but they are moot in view of new ground(s) of rejection. Applicant is asked to please refer to the modified prior art rejections above where examiner addresses applicant's concerns regarding the new limitations.

#### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

Victor X Nguyen  
Examiner  
Art Unit 3734

VN  
4/7/2008